

**Remarks/Arguments**

**Objection to Claim of Foreign Priority**

The Examiner has stated that Applicant has not complied with one or more conditions for receiving the benefit of an earlier under 35 U.S.C. § 120. Specifically, the Examiner states the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirement of 35 U.S.C. § 112, first paragraph.

As there is no definite explanation as to the type of compliance failure under § 112, first paragraph, Applicant assumes that the failure results from the addition of new matter in the Preliminary Amendment filed December 8, 2003. As explained below, Applicant has amended Claims 6 and 12 to remove the alleged new matter. In light of the amendments to Claims 6 and 12, Applicant respectfully requests reconsideration and removal to the objection to the claim of foreign priority under 35 U.S.C. § 120.

**Amendment to the Drawings**

The Examiner objected to the drawings as not depicting every feature of the invention specified in the claims. Specifically, the Examiner noted that the feature related to the arrangement of a motor or a lamp in the microscope stand as claimed in Claims 6 and 12 was missing from the drawings. Applicant thanks the Examiner for noting this omission. Applicant has amended Figure 3 to include a schematic of a motor (reference number 9) positioned in a microscope stand (reference number 32). The amended figure is attached in an Appendix at the end of this paper.

The Examiner also objected to Figure 3 as showing new matter added to the application as originally filed. As discussed below, Applicant has amended Claims 6 and 12 and the specification to remove the new matter. Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings.

Amendment to the Specification

Applicant has amended Paragraph 0021.1 of the specification to delete that use of “at least one” slide-in standardized circuit board in the control and power supply unit 34. Applicant has added the use of “two or more” standardized circuit boards in the control and power supply unit 34. Support of this amendment can be found in original paragraph 0008 describing the use of multiple identical circuit boards. Applicant courteously points out that Paragraph 0006 describes the use of a box in which at least one control and power supply unit is installed and that the box is arranged separately from the microscope stand. Clearly, the multiple circuit boards described in Paragraph 0008 are installed in the separate box as that box contains the control and power supply units which comprise the multiple circuit boards. Additional support can be found in United States Patent No. 6,717,725 (“the ‘725 patent”) Col. 1 line 66-Col. 2, line 2, which is the parent patent of the instant application.

Objection under 35 U.S.C. § 132 (New Matter)

The Examiner has objected to the preliminary amendment filed December 8, 2003 under 35 U.S.C. § 132 as introducing new matter. Specifically, the Examiner states that the brief description of Figure 3, Figure 3 itself, and the description of the structure in new paragraph 0021.1 introduce new matter in the form of the “at least one slide-in standardized circuit board” in the control and power supply unit as claimed in new Claims 6 and 12. Applicant thanks the Examiner for pointing out this material.

As discussed below, Applicant has amended Claims 6 and 12 to remove the claim limitation “at least one slide-in standardized circuit board” and replaced it with “two or more standardized circuit boards.” In light of the amendments to Claims 6 and 12, Applicant respectfully requests reconsideration and removal of the new matter objection.

Rejection of Claims 6-17 under § 112, first paragraph

The Examiner has rejected Claims 6-17 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner states that the claims contain subject matter which is not described in the specification so as to convey that the Applicant had possession of the claimed invention at the time of filing. Applicants have amended Claims 6 and 12 and request reconsideration of the rejection and passage to allowance of those claims.

Applicant has amended Claims 6 and 12 to delete the claimed limitation of “at least one slide-in” standardized circuit board and to add the limitation “two or more” standardized circuit boards. Support for these amendments is found in amended paragraph 0021.1 of the specification. (See above the discussion of the amendment to the specification.) Because amended Claims 6 and 12 contain no new matter, Applicant respectfully requests reconsideration and removal of the rejection of Claims 6 and 12 under § 112, first paragraph.

Claims 7-11 and 13-17 depend from Claims 6 and 12, respectively and therefore incorporate all the limitations of those claims. Because the amendments to Claims 6 and 12 remove the new matter deficiency and add a new limitation supported in the specification of the instant application and the parent patent, Applicant respectfully submits that Claims 7-11 and 13-17 no longer contain new matter. Applicant respectfully requests reconsideration and removal of the rejection of those claims under § 112, first paragraph.

The Examiner has rejected Claims 10 and 16 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner states that Claims 10 and 16 contain subject matter that is not described in such a way as to reasonably convey to one skilled in the relevant art that the Applicant has possession of the invention at the time the application was filed. Applicant respectfully traverses this rejection and requests reconsideration.

Regarding both Claims 10 and 16, the Examiner states the original disclosure does not provide support for an illuminating system with an illumination unit in a box housing a control and power supply unit, a lamp in a microscope stand, and a cable for guiding light from the

illumination unit to the stand. Applicant courteously points out that Paragraph 0021, lines 5-9 describe "...using a light guide, the light generated by a lamp (not depicted) in control and power supply unit 34 is transported to microscope stand 32, where it is coupled in suitable fashion into the optical beam path to microscope 32 and illuminates a specimen. It is also conceivable for the lamp to be built into the microscope." (Emphasis added.) While the Examiner correctly states that a transformer is in the box, Applicant respectfully points out Paragraph 0021 also clearly describes a lamp, obviously an illumination unit, within the box, and a light guide cable coupling light from the lamp with the microscope stand thus providing a clear written description of Claims 10 and 16. Moreover, the cited lines clearly differentiate between a lamp in the box and a lamp in the microscope. Applicant respectfully requests reconsideration and removal of the rejection of Claims 10 and 16.

The Examiner has rejected Claims 6-17 under 35 U.S.C. § 112, first paragraph for failing to comply with the enablement requirement. Applicant has amended Claims 6 and 12 to remove the limitation of at least one slide-in circuit board and added the limitation two or more standardized circuit boards. Applicant respectfully traverses the rejection of the amended claims and requests reconsideration.

Applicant courteously points out that the original specification as filed and the parent application both describe the use of multiple circuit boards. (See paragraph 0008 of the instant application as well as the parent application, the '725 patent col. 1, line 66 to col. 2, line 2.) As noted previously, the specification describes the use of multiple circuit boards in the context in which a single box can be equipped with multiple circuit boards that can be used with different microscopes. See paragraph 0008, lines 21-23 describing the concept in which different individual circuit boards do not have to be produced for each microscope stand as multiple (two or more) circuit boards that work with different microscopes can be installed in a single box. Applicant respectfully submits that it would be obvious to one of ordinary skill in that art to connect the circuit board to the motor or lamp as these are components that a microscope user would want to control when using a microscope.

Applicant respectfully notes that the term “standardized” as used in Claims 6 and 12 is synonymous with the term “identical” used in paragraph 0008 and refers to circuit boards of the same physical size and shape that would fit into a single box. As described in the instant application, the terms “standardized” and “identical” do not refer to identical circuits on the circuit boards as the specification clearly describes the use of a single box with different microscopes which would clearly require circuit boards holding different electrical circuits. Just as clearly, it would be preferable to use circuit boards with the same physical shape and size to fit into the single box.

Applicant respectfully asserts that undue experimentation would not be needed to make the standardized circuit board as its use in a box is described in the issued parent ‘725 patent. In both the instant application and the ‘725 patent, control and power supply units are described that house controls for power supplies for a lamp, motors and other components. Moreover, both the instant application and the parent patent describe the use of circuit boards in the box which is analogous to the control and power supply unit. Consequently, it can be seen that the specification of the instant application clearly enables a person of ordinary skill in the art to make two or more circuit boards of identical size that fit into a box or control and power supply unit to control a lamp and/or motor in a microscope. Applicant respectfully requests reconsideration removal of this rejection under § 112, first paragraph for lack of enablement.

Claims 7-11 and 13-17 depend from Claims 6 and 12, respectively, and therefore incorporate all the limitations of those claims. Because, as discussed above, the instant application does enable amended independent Claims 6 and 12, Applicant respectfully submits that Claims 7-11 and 13-17 are also enabled. Applicant respectfully requests reconsideration and removal of the enablement rejection of those claims.

The Examiner has rejected Claims 10 and 16 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. The Examiner states that Claims 10 and 16 contain subject matter that is not described in such a way as to enable one skilled in the relevant

art to make and use the invention. Applicant respectfully traverses this rejection and requests reconsideration.

Regarding both Claims 10 and 16, the Examiner states that the disclosure does not provide support for an illuminating system having an illumination in a box housed in a control and power supply unit, a lamp in a microscope stand and cable for guiding light from the illumination unit to the microscope. As discussed above, the term "box" is used to indicate the control and power supply unit. The illumination unit is not located in a box separate from the control and power supply unit but is housed with the control and power supply unit which is a box. Applicant refers the Examiner to Claims 6 and 12 from which Claims 10 and 16, respectively, depend. Claims 6 and 12 both describing a box "including at least one control and power supply unit, said box arranged physically separate from said microscope stand" which clearly describes that the control and power unit is housed within (or perhaps on) a box separated from a microscope or microscope stand. Emphasis added. Consequently, in Claims 10 and 16, when an illumination unit is claimed within said box, it is separate from the microscope stand and not within the microscope stand as stated by the Examiner. Applicant notes paragraph 0021, lines 5-8 of page 6, describing the automated microscope system claimed in Claims 10 and 16. Applicant respectfully requests reconsideration and removal of the rejection of Claims 10 and 16 under § 112, first paragraph for lack of enablement.

#### Double Patenting Rejection under § 101

The Examiner objected to Claims 12-17 under 37 CFR § 1.75 as being a substantial duplicate of Claims 6-11. The Examiner states that the only difference between independent Claims 6 and 12 is the limitation in Claim 12 containing at least one control and power supply unit further comprising a power supply for said microscope." Applicant has amended independent Claim 12 and respectfully requests reconsideration.

Applicant has amended independent Claim 12 to claim an automated microscope in which the box includes at least one control and power supply in which to control at least one motor and at least one motor. Thus, amended Claim 12 claims an embodiment in which both at

least one lamp and at least one motor are controlled two or more standardized circuit boards. This differs from the embodiment claimed in Claim 6 in which a two or more standardized circuit boards are used for controlling at least one motor or one lamp within a microscope stand. Support for this amendment is found in Paragraph 0020 of the original specification in which the control and power supply unit 34 is described as a closed box in which both control and power supply units are housed such as for lamps and motors. Applicants respectfully request reconsideration and passage to allowance of amended Claim 12. Applicant has amended Paragraph 0021.1 to reflect the amendment to Claim 12.

Claims 13-17 depend from Claim 12 and thus incorporate all the limitations of that claim. Because, as discussed above, amended Claim 6 and amended Claim 12 do not claim substantially the same invention, Applicant respectfully requests the removal of the rejections of Claims 13-17 and passage to allowance of those claims.

The Rejection under § 102 (b) of Claims 6-9 and 12-15

The Examiner rejected Claims 6-9 and 12-15 under 35 U.S.C. § 102 (b) as anticipated by United States Patent No. 5,559,631 to Remer, et al. ("Remer" or "the Remer patent"). Applicant has amended independent Claims 6 and 12 from which Claims 7-9 and 13-15, respectively, depend. Applicant respectfully traverses the rejection of the claims as amended and requests reconsideration.

"Every element of the claimed invention must be literally present arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.) Applicant courteously points out that both amended Claims 6 and 12 each claim an automated microscope system including two or more standardized circuit boards. Applicant respectfully notes that Remer does not explicitly disclose the use of any type or number of circuit boards, let alone two or more standardized (or identical) circuit boards configured to control and power "various types" of microscopes stands. Consequently, the Remer patent fails as a reference under § 102 (b) as it not only fails to disclose the claimed standardized circuit boards, but also fails to disclose that various types of microscopes can be powered from the one box

housing the standardized circuit boards. Applicant respectfully requests reconsideration and passage to allowance of Claims 6 and 12.

Claims 7-11 and 13-16 depend from Claims 6 and 12 respectively and thus incorporate all the limitations of those claims. Because, as discussed above, the Remer patent fails to anticipate all the elements of Claims 6 and 12, it also fails to anticipate Claims 7-9 and 13-15. Applicants respectfully request the removal of the rejections to Claims 7-11 and 13-16 and passage to allowance of those claims.

Rejection under § 103 (a) of Claims 6-9, 11-15, and 17

The Examiner rejected Claims 6-9, 11-15, and 17 under 35 U.S.C. § 103 (a) as obvious over United States Patent No. 5,566,020 to Bradford, et al. ("Bradford" or "the Bradford patent") in view of United States Patent No. 4,862,279 to Tsumazawa, et al. ("the '279 patent"). Applicant has amended independent Claims 6 and 12 and respectfully traverses the rejection of the claims as amended and requests reconsideration.

To establish a *prima facie* case of obviousness there must be some suggestion or motivation to modify the reference(s). In addition, the reference or combination of references must teach or suggest all limitations of the claim at issue. The teaching or suggestion to make the combined combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Emphasis added.

A close examination shows that neither reference discloses the use of two or more standardized circuit boards used for various types of microscope stands. First, the Bradford patent fails to disclose the invention of the instant application as claimed in amended independent Claims 6 and 12, namely the use of a box including a control and power supply unit that has two or more standardized circuit boards used for various types of microscope stands. The Bradford patent does not suggest the use of either power unit 18 or the separate light source 14 as being configured for use with more than one type of microscope. Neither is this suggestion made in the '279 patent which only discusses video cameras and does not mention any circuitry



or other components adapted for use with different types of video cameras, let alone different types of microscopes. For this reason, the combination of the Bradford patent and the '279 patent fails to disclose all of the elements of independent amended Claims 6 and 12 and also fails to provide any suggestion or teaching to combine these two references in a valid obviousness rejection under § 103 (a).

Moreover, Applicant has amended Claims 6 and 12 to delete the "slide-in" claim limitation thereby rendering moot the '279 patent as a reference under § 103 (a). In addition, the deleted slide-in limitation referred to slide-in circuit boards not sliding on-off switches used to turn on a microscope. Consequently, the '279 patent does not describe or disclose any claim limitation in Claims 6-9, 11-15, and 17 and is thus invalid as a reference under § 103 (a).

The Examiner stated that the originally claimed "at least one slide-in standardized circuit board" is new matter. As noted above, Applicant has amended Claims 6 and 12 to remove the new matter substituting "two or more standardized circuit boards" for the alleged new matter. Support for amended Claims 6 and 12 are found in paragraphs 0005-0008 and 0021 as discussed above.

Attorney Docket No. LWEP:104aUS  
U.S. Patent Application No. 10/728,530  
Reply to Office Action of August 23, 2004  
November 23, 2004

**Conclusion**

Applicant respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



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## **Appendix**

Attorney Docket No. LWEP:104aUS  
U.S. Patent Application No. 10/728,530  
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November 23, 2004

### **Amendments to the Drawings**

The drawings have been amended as follows:

Figure 3 has been amended to include a schematic representation of a motor (reference no. 9) positioned within the microscope stand (reference no. 32).